



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,769	10/17/2001	Tasneem S. Rangwala	38-21(52249)	4211

27161 7590 02/24/2003

MONSANTO COMPANY
800 N. LINDBERGH BLVD.
ATTENTION: G.P. WUELLNER, IP PARALEGAL, (E2NA)
ST. LOUIS, MO 63167

EXAMINER

KRUSE, DAVID H

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 02/24/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,769

Applicant(s)

RANGWALA ET AL.

Examiner

David H Kruse

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1, 2, 5-7 and 12, drawn to a DNA molecule identified as SEQ ID NO: 7, primers comprising a sequence or complement thereof of SEQ ID NO: 7, a method of detecting the presence of DNA corresponding to event PV-GHGT07 using said DNA and the amplicon produced by said method, classified in class 435, subclass 6, for example.
 - II. Claims 3, 4, 8-10 and 13, drawn to a DNA molecule identified as SEQ ID NO: 8, primers comprising a sequence or complement thereof of SEQ ID NO: 8, a method of detecting the presence of DNA corresponding to event PV-GHGT07 using said DNA and the amplicon produced by said method, classified in class 435, subclass 6, for example.
 - III. Claim 11, drawn to a method of detecting the presence of DNA corresponding to event PV-GHGT07 using a polynucleotide probe, classified in class 435, subclass 6, for example.
 - IV. Claim 14, drawn to a method of breeding cotton using a molecular marker, classified in class 800, subclass 267, for example.
 - V. Claims 15, 20 and 21, drawn to a method of determining the zygosity of the progeny of cotton plant PV-GHGT07, classified in class 435, subclass 6, for example.

- VI. Claim 16, drawn to an isolated DNA nucleotide primer comprising SEQ ID NO: 9, classified in class 536, subclass 24.3, for example.
- VII. Claim 17, drawn to an isolated DNA nucleotide primer comprising SEQ ID NO: 10, classified in class 536, subclass 24.3, for example.
- VIII. Claim 18, drawn to an isolated DNA nucleotide primer comprising SEQ ID NO: 11, classified in class 536, subclass 24.3, for example.
- IX. Claim 19, drawn to an isolated DNA nucleotide primer comprising SEQ ID NO: 12, classified in class 536, subclass 24.3, for example.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA molecule(s) of Group I is compositionally, structurally and functionally distinct from the DNA molecule(s) of Group II. In addition, the method encompassed by Group I has different starting materials and different end products than the method encompassed by Group II.
- 3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method

encompassed by Group I has different starting materials, different method steps and different end products than the method of Group III.

4. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method encompassed by Group I has different starting materials, different method steps and different end products than the method of Group IV.
5. Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method encompassed by Group I has different starting materials, different method steps and different end products than the method of Group V.
6. Inventions I and VI-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA nucleotide primer of any one of Groups VI-IX cannot be used in the method encompassed by Group I.
7. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method encompassed by Group II has different starting materials, different method steps and different end products than the method of Group III.

8. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method encompassed by Group II has different starting materials, different method steps and different end products than the method of Group IV.

9. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method encompassed by Group II has different starting materials, different method steps and different end products than the method of Group V.

10. Inventions II and VI-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the DNA nucleotide primer of any one of Groups VI-IX cannot be used in the method encompassed by Group II.

Art Unit: 1638

11. Inventions III-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the methods of Groups III-V each have different method steps, different starting materials and different end products.

12. Inventions III and VI and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of Group III can be practice using a materially different product, such as a nucleotide primer having the sequence of SEQ ID NO: 5 or 6. In addition, the product of either Group VI or VII can be used in a materially different process, such as in a DNA sequencing method.

13. Inventions III and VIII and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because neither DNA nucleotide primer of Group VIII or IX can be used in the method of Group III.

14. Inventions IV and VI-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

Art Unit: 1638

operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the nucleotide primer of any one of Groups VI-IX cannot be used in the method of breeding cotton of Group IV.

15. Inventions V and VI, VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleotide primer of any one of Groups VI, VII and IX can be used in a materially different process than the method of determining zygosity of Group V, such as in a DNA sequencing method.

16. Inventions VI-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because each of the nucleotide primers of Groups VI-IX are structurally, compositionally and functionally distinct.

17. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

Art Unit: 1638

18. Applicant is advised that the reply to this requirement to be complete within one month (not less than 30 days) must include an election of the invention to be examined even though the requirement be traversed (37 § CFR 1.143).

19. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-0196.



David H. Kruse, Ph.D.
20 February 2003

AMY J. NELSON, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600